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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,946	12/13/2000	Geoffrey Darby	918.0001USU	8098

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,946

Applicant(s)

DARBY ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 18a and 33e. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 35 discloses the limitation "during the time that the first are of the television monitor screen". The examiner cannot determine what "the first are" is referring to. For the remainder of this Office Action, the examiner will interpret claim 35 to be equivalent to the limitations in claim 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-2, and 4-22, 24, 26-27, 29-35 and 37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bendinelli et al. (U.S. Patent No. 6,061,719).

Referring to claim 1, Bendinelli discloses transmitting a television signal (see Column 3, Lines 16-19 and Figure 1) such that a first area of a television monitor screen (Display 38 in Figure 3) displays programs (see Column 5, Lines 33-35) and advertisements (note that a television program contains commercial breaks (see Column 3, Lines 21-24), therefore, the television signal contains both the television program ("Friends" for example) and commercial breaks ("an advertisement to buy toothpaste")), and a second area of the television monitor screen displays other information (see PIP window for displaying other information (see Column 5, Lines 37-40).

Bendinelli also discloses that during a time that the first area of the television monitor screen is displaying an advertisement for an advertiser, displaying information in said second area for specifying an address of a location in a global data communication system where the advertiser can be contacted (see Column 3, Lines 21-24 for displaying an advertisement in a second area, and Column 3, Lines 47-50 for displaying the actual web address in the second area).

Referring to claim 2, see rejection of claim 1, and again note Column 3, Lines 21-24 for displaying an advertisement in a second area, and Column 3, Lines 47-50 for displaying the actual web address (URL) in the second area.

Referring to claim 3, Bendinelli teaches a PIP window 44 in Figure 3, which is a stripe across the bottom of the display 38.

Referring to claim 4, Bendinelli discloses at Figure 3 for the PIP window 44 being smaller than the display window 38, which is about 12% of the total display.

Referring to claim 5, see rejection of claim 2, and note that displaying the actual URL is displaying text to the display window 38 (for example, displaying <http://www.google.com>).

Referring to claim 6, Bendinelli discloses that the program can be an advertisement (see Column 3, Lines 21-24) or an actual program (see viewing music videos at Column 3, Lines 27-29), therefore there is a time where a first area is displaying program and another time where advertisements are displayed. Also note that at Column 4, Lines 3-8 and 34-37 Bendinelli discloses that the data in the second area is only changed when a new URL is sent to the set-top box, therefore if a program goes to commercial, if there is no URL in the closed caption stream, then there will inherently be no change in the second area even after the commercial has finished airing.

Referring to claims 7-12, Bendinelli discloses displaying a web page according to the URL embedded in the television signal at Column 3, Lines 57-63 and the actual URL at Column 3, Lines 21-24. The examiner notes that the additional claims 8-12, which teach different types of information being displayed in the second window, can be provided by either displaying the actual URL to the user or the web page to which the

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URL addresses, therefore rendering these claim limitations non-functional descriptive claim language (see MPEP section 2106 IV (pages 2100-21 and 2100-22)).

Referring to claim 13, see rejection of claims 2 and 3.

Referring to claims 14-21, see rejection of claims 4-5 and 7-12, respectively.

Referring to claim 22, see rejection of claim 6 and note that if the web page being displayed in PIP window 44 is controlled by when the URL is transmitted to the set-top box, then the system inherently can change the display in PIP window 44, before, during or after the commercial advertisement is transmitted.

Referring to claim 24, Bendinelli discloses that the further information is related to the commercial appearing in the second area (see Column 3, Lines 21-24).

Referring to claim 26, see rejection of claim 1, and also note that Bendinelli discloses a combiner for combining a television signal (which includes ad signals (commercials)) and an information signal (URL) into a unified signal at Column 5, Lines 9-13).

Referring to claims 27-32, see rejection of claims 2-7, respectively.

Referring to claim 35, see rejection of claim 22.

Referring to claim 37, see rejection of claim 26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Portuesi (U.S. Patent No. 5,774,666).

Referring to claim 23, Bendinelli discloses all of the limitations in claim 13, as well as displaying further information in the stripe, where the information comprises an identification of the advertiser (see Column 3, Lines 21-24). Bendinelli fails to disclose that the identification being displayed extends beyond a top border of the stripe into the first area. Portuesi teaches in Figure 3, displaying a URL 32 in the first area, while a caption identifying the advertiser is displayed in caption stripe 34, where the URL 32 is above the top border of the stripe 34 (see also Column 5, Lines 59-67 and Column 6, Lines 1-19).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the display of Bendinelli, using the additional information (element 32 in Figure 3), as taught by Portuesi, for the purpose of providing hot spots on the display for users to access (see Column 3, Lines 16-18 of Portuesi).

Referring to claim 36, see rejection of claim 23.

5. Claims 25 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al. (U.S. Patent No. 6,061,719) in view of Alexander et al. (U.S. Patent No. 6,177,931).

Referring to claim 25, Bendinelli discloses all the limitations in claim 26, as well as displaying further information in the stripe, but fails to teach that the information in the stripe being a function of a type of viewing audience of a program with which the

commercial appears. Alexander teaches developing a user profile, which can be used to define the display of additional information in a second region of the screen (see Column 30, Lines 45-58).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the display of Bendinelli, using the viewer profile used for customizing a display for an audience (the user), as taught by Alexander, for the purpose of providing the user with improved viewer interaction capabilities with the display (see Column 2, Line 5 of Alexander).

Referring to claim 39, see rejection of claim 25.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The International Search report submitted contained two relevant "X" references.

Thrift (EP 0 852 361 A2), describes a graphical user interface along with the television program, which also includes a second area used to display other information, such as web pages and other secondary information.

Allison (WO 99/56473), also describes a graphical user interface displayed along with the television program, and displays secondary information (web pages, etc.) that are related to the program being shown.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-


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1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

November 20, 2003


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600